



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

M

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,117	08/09/2001	Robert Briggs Phillips	VTN-0549	2698
27777	7590	11/28/2003	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
			DATE MAILED: 11/28/2003	

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,117

Applicant(s)

PHILLIPS ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment B, presented as Paper No. 11. Claims 1-22 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. In light of the applicant's amendment, the objection to the abstract is hereby withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 1-7 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 6,082,533).

Regarding claim 1, Smith et al discloses (Figures 5 and 6) a disposable contact lens package (300) with a raised seal volume (310), base (312), top surface (371), perimeter top surface (370), and recessed well (314). Package (300) is sealed with lidstock (Col. 3, ll. 4-9). Smith et al discloses raised surface (310) as arcuate in shape to prevent the collection of aqueous fluid on its surface (Col. 3, ll. 9-12). Smith et al discloses the claimed invention except for two linear sides intersecting the horizontal plane at angles having values from 125 to 170 degrees.

Smith et al further discloses an alternate embodiment (200) with a linear side (220) having an angle greater than or equal to 90 degrees (Col. 2, ll. 38-42) instead of an arcuate side. Smith et al shows that linear sides are an equivalent structure known in the art with respect to the movement of fluids from the top surface of a raised volume. Therefore, because these two geometric configurations were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute linear sides for arcuate sides.

As to the angles having values from 125 to 170 degrees, Smith et al discloses linear sides with angles greater than or equal to 90 degrees (encompassing the range of angles from 125 to 170 degrees) and therefore discloses the claimed invention except for expressly disclosing angles from 125 to 170 degrees. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package (Smith et al, 300 with linear sides substituted for arcuate sides) with angles from 125 to 170 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to claims 2, 3, 5-7, and 10-17, the package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claim 1 above discloses the claimed invention except for the specific dimensions claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with dimensions as claimed by the applicant, since it

Art Unit: 3728

has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to claim 4, Smith et al discloses raised seal volume (310) located 0.2 mm from the perimeter of the well (Col. 2, ll. 66-67).

As to claims 18 and 22, Smith et al discloses rounded surfaces (260, 360) at the peak of the raised seal volume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include this feature in the package (Smith et al, 300 with linear sides substituted for arcuate sides) in order to maintain the fluid dispersing properties of the raised seal volume.

As to claims 19-21, the package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claims 1, 17, and 18 above discloses the claimed inventions except for the specific radii claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with radii as claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

5. Claims 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al as applied to claims 1 and 6 above, and further in view of Lust et al (5,704,468) and Abrams et al (US 5,467,868).

The package (Smith et al, 300 with linear sides substituted for arcuate sides) as applied to claims 1 and 6 above discloses the claimed inventions except for the specific

distances claimed by the applicant. Lust et al (Figures 4, 8, and 13) and Abrams et al (Figure 3) disclose that it is known in the art to place the raised seal volume at a distance from the perimeter of the well. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Smith et al with distances as claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

6. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

7. The applicant fails to argue the assertion presented by the examiner that the arcuate sides of the Smith et al raised seal volume is a geometric equivalent to the claimed linear sides for the purpose of fluid flow away from the top portion. Applicant argues that Smith et al teaches a substantially perpendicular arrangement. As noted by the examiner, Smith et al discloses, "[I]t is noted that wall 220 does not need to be exactly perpendicular to top surface 160..." (Col. 2, ll. 38-40). The examiner uses the linear side as a teaching for the shape substitution presented. The fundamental principal of the applicant's invention is the use of geometric shape to direct the flow of fluids away from either side of the peak of the raised seal volume. Smith et al teaches this principal. The optimization of the shape using elementary geometry to include the

linear sides and dimensions claimed by the applicant is within the level of ordinary skill in the art.

8. Lust et al and Abrams et al teach the spaced apart raised seal volume, not the linear sides. The examiner interprets the lack of argument on this point as a concession of obviousness.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

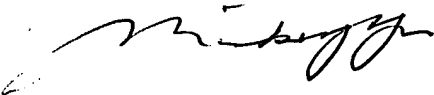
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Gregory Pickett
Examiner
November 17, 2003


Mickey Yu
Supervisory Patent Examiner
Group 3700